PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Michael J. BORG

Application No.: 09/991,752

Filing Date: 26 NOV. 2001

Title: METHOD FOR AUTOMATICALLY COMPLETING AN ELECTRONIC FORM

Confirmation No.: 3959

Examiner: LIN, Wen Tai

Group Art Unit: 2154

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PO Box 1450
Alexandria, VA 22313-1450

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TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on __30 JUN. 2006__ .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( )   (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

      ( )   one month $120.00
      ( )   two months $450.00
      ( )   three months $1020.00
      ( )   four months $1590.00

     ( ) The extension fee has already been filled in this application.

(X)   (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of __$500.00__. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Rev 12/04 (Aplbrief)

Respectfully submitted,

Michael J. BORG

By _____

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PATENT APPLICATION
Docket No.: 10007023-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Inventor(s):	Michael J. BORG
Serial No.:	09/991,752
Filed:	November 26, 2001
Title:	METHOD FOR AUTOMATICALLY COMPLETING AN ELECTRONIC FORM
Art Unit:	2154
Examiner:	LIN, Wen Tai
Confirmation No.:	3959

Mail Stop APPEAL BRIEF – PATENTS
Commissioner for Patents
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APPEAL BRIEF

SIR OR MADAM:

This communication is the Appeal Brief in this application as filed contemporaneously with the corresponding Notice of Appeal on June 30, 2006. This Appeal Brief is being filed under the provisions of 37 C.F.R. § 41.37. The filing fee for this Appeal Brief, as set forth in 37 C.F.R. § 41.20, was submitted in association with an earlier-filed Appeal Brief in this Application on September 23, 2005. The Appellants believe that no additional fee is due, in accordance with 35 U.S.C. § 134(a).

(Continued on next page.)

1. Real Party In Interest:

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

2. Related Appeals and Interferences:

There are no other appeals or interferences known to the Appellant, the Appellant's legal representative, or assignee which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

3. Status of the Claims:

The following list provides the status of all the claims in the application:
Claims 1-20: rejected – currently on appeal.

4. Status of Amendments:

No amendments to the claims were made, filed or entered after the final action.

5. Summary of Claimed Subject Matter:

In one aspect, the present invention provides an automated data entry method (Fig. 4), comprising entering user information (410 of Fig. 4) at a first location, and then searching a storage medium (340 of Fig. 3) at said first location to determine an identity of a user based on the entered information (415 of Fig. 4; and pg. 5, lines 21-27 of Specification). The method includes accessing a storage medium at a second location (325 of Fig. 3; and 445 of Fig. 4), upon not being able to identify a user by searching the storage medium at said first location. The medium at the second location contains information for a plurality of users (pg. 4, line 22 to pg. 5, line 10 of the Specification). The method also includes searching the storage medium at the second location (450 of Fig. 4) to determine an identity of said user based on the entered information (pg. 6, lines 12-17 of Specification). The method further includes retrieving additional information pertaining to the user from the storage medium at the first or second

locations based on the determined identity (430 and 435 of Fig. 4; and pg. 6, lines 4-10 and 18-24 of Specification).

In another aspect, the present invention provides a system including a first website (330 of Fig. 3) corresponding to a vendor of products or services, the first website having a storage medium (340 of Fig. 3) containing user information corresponding to a plurality of individuals. The system includes a second website (320 of Fig. 3) having a storage medium (325 of Fig. 3) containing user information corresponding to a plurality of individuals. The system also includes a network connecting said first and second websites (300 of Fig. 3; and pg. 5, lines 5-10 of Specification). The system includes a user station (310 of Fig. 3) connected to the network, the first website comprising a software application (335 of Fig. 3) being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to information entered through a user interface of the user station (pg. 5, line 12 to pg. 6, line 24 of Specification). Also, the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites (pg. 5, lines 24-27; and pg. 6, lines 12-14 of Specification).

6.   Grounds of Rejection to be Reviewed on Appeal:

(A).   Whether claims 1-11 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,199,079 ("Gupta '079"), in view of U.S. Patent No. 5,826,258 ("Gupta '258).

(B).   Whether claims 12-20 are unpatentable under 35 U.S.C. § 103(a) over Gupta '079 in view of Gupta '258.

7.   Argument:

(A).   Neither Gupta '079 nor Gupta '258 provides, teaches or suggests all of the elements and limitations as recited by Claims 1-11.

A1.   Claims 2-11 depend (directly or indirectly) from Independent claim 1. Therefore, claims 2-11 include all of the elements and limitations of claim 1, in combination with their own respective elements and limitations.

Claim 1 recites:

> An automated data entry method comprising:
>
> entering a user information at a first location;
>
> searching a storage medium at said first location to determine an
> identity of a user based on the entered information;
>
> accessing a storage medium at a second location upon not being
> able to identify a user by searching the storage medium at said first
> location, said medium at the second location containing information for a
> plurality of users;
>
> searching the storage medium at the second location to determine
> an identity of said user based on the entered information; and
>
> retrieving additional information pertaining to the user from the
> storage medium at the first or second locations based on the determined
> identity.

Thus, under pending claim 1 (and rejected claims 2-11 that depend therefrom), a method is provided wherein a user inputs information at a first location. Responsive thereto, user information pre-stored at that first location is searched in order to determine that user's identity. In the event that the user's identity cannot be determined based on the pre-stored data at the first location, a second location including pre-stored user information is searched using the same user input information so as to determine the user's identity. Once a user's identity has been successfully determined, additional information is retrieved from the first or second locations. In this way, two electronic sources can be searched as needed to determine a user's identity and to extract additional information related to that user based on a relatively minimal initial input. For example, the user input information can include a last name and a zip code (pg. 5, lines 27-28 of the Specification). Also, for example, the first location and the second location can ·be defined by a vendor website and a data website, respectively (pg. 5, lines 24-27; and pg. 6, lines 12-14 of the Specification). Furthermore, for example, the additional user information retrieved from the first or second location can include a telephone number, age range, etc. (pg. 7, lines 3-8 of the Specification). Please also refer at least to page 5, line 21 to page 7, line 14 of the Specification as originally filed.

A2.   Gupta '079 (6,199,079) teaches the automatic completion of online forms, such as those encountered by a user while shopping via the Internet (Abstract; Figs. 2C-2D of Gupta, et seq.). Under Gupta '079, various user-information fields (202, 204, 206, etc.) within an online form (201) are automatically filled in using user data pre-stored within a User Meta-database (170) (Col. 8, lines 15-21 of Gupta '079). However, Gupta '079 fails to provide any teachings or suggestions relating to searching, accessing or in any way utilizing a *second location* (of any kind) for purposes of *identifying a user* and/or retrieving *additional* (or any) *user information* from such a *second location*. Gupta '079 teaches the storage of user information in and the retrieval of user information from the User Meta-database 170 <u>exclusively</u>. In short, Gupta '079 teaches a system configured about a <u>single</u> electronic source of user information, and no other.

The Examiner has admitted to the foregoing deficiencies of Gupta '079 (page 3 of Final Office Action). Nonetheless, the Examiner asserts that Gupta '079 teaches searching a storage medium at a first location to determine an identity of a user based on entered information (page 3 of Final Office action). Respectfully, this assertion is mistaken. In fact, Gupta '079 is completely lacking of any teachings or suggestions directed to *determining a user's identity* in any way or for any reason.

In any case, Gupta '079 fails to provide, teach or suggest an automated data entry method, including: 1) accessing a storage medium at a *second location* upon not being able to *identify a user* by searching the storage medium at said first location; 2) searching the storage medium at the *second location* to *determine an identity* of said user based on the entered information, and 3) retrieving additional information pertaining to the user from the storage medium at the *first or second* locations based on the *determined identity*, as recited by claim 1. Accordingly, it is impossible for the recitations of Gupta '079 to provide, teach or suggest all of the elements of Appellants' Claim 1.

A3.   Gupta '258 (5,826,258) teaches the use of a "wrapper" (504) for determining how semi-structured information within a source (502) is organized, wherein the wrapper serves to extract from the examined information and to report "structures" or "patterns of interest" identified therein for later use during data queries (Abstract; Col. 2, lines 27-50; Fig. 10 of Gupta '258). Furthermore, Gupta '258 teaches that such wrappers are dedicated to (i.e., customized, or specifically defined for) each

information resource under scrutiny (Abstract; Col. 2, lines 23-26; Fig. 4 of Gupta '258). However, Gupta '258 is completely missing any of the terms "user identity", "identity of a user", "determining an identity of a user", or any of their respective equivalents, in any context or for any purpose. The Examiner fails to address these deficiencies of Gupta '258 in any way.

Despite the foregoing facts and deficiencies of the art of record, the Examiner asserts the following chain of reasoning: 1) that Gupta '258 teaches the coupling of a plurality of wrappers (554) and a mapper (556) to a standard relational database (562) so as to extract information from additional resources (552) (e.g., vendor websites 139, 149 and 159) that are connected to the wrappers by way of the transaction integrator (100) of Gupta '079; 2) that, *by default*, each vendor (of Gupta '079) keeps records of customers who made purchases through each respective website; and therefore 3) it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate the mapper software of Gupta '258 into the transaction integrator of Gupta '079 because such modifications would enable the form filler (110) of Gupta '079 to extract customer information directly from the resource vendor's local site when the customer's data has not yet been collected into the databases of Gupta '079... (Pages 3-4 of Final Office action).

Respectfully, the Examiner's chain of reasoning as presented immediately above is deficient and misleading for at least the following reasons: 1) nothing within Gupta '079 teaches or suggest that any such vendor websites make any sort of customer data available to anyone accessing those sites, assuming *arguendo* that such customer data is in fact kept at such sites as the Examiner insists – such customer data is typically closely guarded by way of firewall protection schemes and the like; and 2) none of the means or methods taught or suggested by either Gupta '079 or Gupta '258 are directed to determining an identity of a user. Frankly, the Examiner has read teachings and/or suggestions into Gupta '079 and Gupta '258 that simply are not present in either of those references.

In any case, Gupta '258 fails to cure the deficiencies of Gupta '079, because neither Gupta '079 nor Gupta '258 provide, teach or suggest an automated data entry method, including: 1) accessing a storage medium at a *second location* upon not being able to *identify a user* by searching the storage medium at said first location; 2) searching the storage medium at the *second location* to *determine an identity* of said

user based on the entered information, and 3) retrieving additional information pertaining to the user from the storage medium at the *first or second* locations based on the *determined identity*, as recited by claim 1. Thus, the combination of Gupta '079 and Gupta '258 fails to teach or suggest all of the elements and limitations as recited by claims 1-11. Such deficiencies on the part of Gupta '079 and Gupta '258 render the § 103 rejection of claims 1-11 unsupportable in view of the requirements of MPEP 706.02(j) and MPEP 2143.03.

A4.   In view of the foregoing, the Appellant respectfully submits that the § 103(a) rejection of claim 1 under the combination of Gupta '079 and Gupta '258 must fail for impropriety, and that the Board must accordingly overturn this rejection. It is axiomatic that any claim which depends (directly or indirectly) from an allowable base claim is also allowable. Therefore, the Appellant asserts that claims 2-11 are also allowable at least by virtue of their dependence from allowable claim 1, as well as for their own respectively patentable features and limitations. Thus, the Appellants do not offer specific arguments in response to the respective § 103 rejections of claims 2-11.

(B).   Neither Gupta '079 nor Gupta '258 provides, teaches or suggests all of the elements and limitations as recited by Claims 12-20.

B1.   Claims 13-20 depend (directly or indirectly) from Independent claim 12. Therefore, claims 13-20 include all of the elements and limitations of claim 12, in combination with their own respective elements and limitations.

Claim 12 recites:

A system comprising:

a first website corresponding to a vendor of products or services, said first website having a storage medium containing user information corresponding to a plurality of individuals;

a second website having a storage medium containing user information corresponding to a plurality of individuals;

a network connecting said first and second websites;

and a user station connected to the network, the first website · comprising a software application being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to

information entered through a user interface of the user station, and wherein the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites.

Therefore, under pending claim 12 (and rejected claims 13-20 that depend therefrom), a system is provided wherein a user, by way of a user station, inputs user information to a software application resident at a first website. The software application is programmed to cause a search of user information at the first website and, if necessary, at a second website, so as to identify the user based on the user's input. Upon identification of the user, other user information can be retrieved from the first and/or second websites. By the foregoing means, a plurality of electronic sources of pre-stored user information, each being typically remote to a user station, can be searched and additional user information can be retrieved therefrom in response to an initial user input. Please refer at least to page 5, line 5 to page 7, line 14 of the Specification as originally filed.

B2. Gupta '079 teaches only the use of a single electronic source – namely, the User Meta-database 170 - for any purpose related to storing or accessing user information. Gupta '079 does not teach, suggest or motivate (and thus, does not render obvious): 1) *first and second websites* each including a storage medium containing *user information*; and 2) a software application resident at the first website and programmable to communicate with the *second website*, the software application programmed to *search and to retrieve user information* from the storage medium at the *first and second websites*, as recited by claim 12. There is no showing anywhere within Gupta '079 that, *even if* some sort of useful **customer information** is maintained at any particular vendor's website - and there is no showing that such is the case - that such customer information would be accessible to any outside entity or by way of any means taught by Gupta '079.

Furthermore, Gupta '079 does not teach, suggest or motivate (and thus, fails to render obvious) any such software application that is programmed to *determine the identity of a user* by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of

the *first **and** second websites*, as recited by pending claim 12. Thus, *even if* customer information *were* accessible by some means of Gupta '079 at some vendor's website (and there is no showing that such is the case), Gupta '079 is lacking any means, teachings, suggestions or motivation directed to using that customer information in order to <u>determine an identity of a user</u>. Simply put, the Examiner assumes too much in the way of elemental functionality, accessible vendor website content, and cooperation between the elements of Gupta '079 and the environment in which it operates. Accordingly, Gupta '079 fails to teach or suggest at least the foregoing elements and limitation as positively recited by claim 12.

B3.   Gupta '258 fails to cure the deficiencies of Gupta '079. Specifically, Gupta '258 does not teach, suggest or motivate: 1) *first **and** second websites* each including a storage medium containing *user information*; and 2) a software application resident at the first website and programmable to communicate with the *second website*, the software application programmed to *search and to retrieve user information* from the storage medium at the *first **and** second websites*, as recited by claim 12. Also, Gupta '258 is lacking any <u>software application</u> – or any other means, for that matter - that is programmed to *determine the identity of a user* by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the *first **and** second websites*, as recited by pending claim 12. For at least the foregoing reasons, and for reasons substantially analogous to those argued at (B2) above, Gupta '258 does not provide or suggest the subject matter of the claim 12, or motivate any modifications leading thereto.

Thus, the combination of Gupta '079 and Gupta '258 fails to teach or suggest all of the elements and limitations as recited by claims 12-20. Gupta '079 and Gupta '258 are directed to solving respectively different problems in correspondingly different ways, than the subject matter as recited by claim 12. Such deficiencies on the part of the cited combination of references renders the § 103 rejection of claims 12-20 unsupportable in view of the requirements of MPEP 706.02(j) and MPEP 2143.03.

B4.   In view of the foregoing, and for reasons analogous to those argued at (A) above, the Appellant respectfully submits that the § 103(a) rejection of claim 12 under the combination of Gupta '079 and Gupta '258 must fail for impropriety, and that the Board must accordingly overturn this rejection. The Appellant further asserts that

claims 13-20 are also allowable at least by virtue of their dependence from allowable claim 12, as well as for their own respectively patentable features and limitations. Thus, the Appellants do not offer specific arguments in response to the respective § 103 rejections of claims 13-20.

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Summary

The Applicant respectfully considers claims 1-20 to be in condition for allowance, and respectfully requests the Board to overturn the final rejections of those claims, and further requests that those claims be allowed.
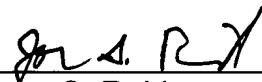
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Dated this 30th day of June, 2006.

Respectfully submitted,

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Michael J. Borg (Applicant)

_____
John S. Reid

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Attorney and Agent for Appellant
Registration No. 36,369
Telephone: (509) 534-5789

8. Claims Appendix:

Claim 1. An automated data entry method comprising:

entering a user information at a first location;

searching a storage medium at said first location to determine an identity of a user based on the entered information;

accessing a storage medium at a second location upon not being able to identify a user by searching the storage medium at said first location, said medium at the second location containing information for a plurality of users;

searching the storage medium at the second location to determine an identity of said user based on the entered information; and

retrieving additional information pertaining to the user from the storage medium at the first or second locations based on the determined identity.

Claim 2. The method of claim 1 further comprising:

establishing communication from the first location to the second location by a programmable software application at the first location.

Claim 3. The method of claim 2 wherein said software application is a browser plug-in module.

Claim 4. The method of claim 1 wherein the first and second locations are connected to a network.

Claim 5. The method of claim 4 wherein the network is the Internet.

Claim 6. The method of claim 1 wherein the first and second locations are respectively defined by a first website and a second website.

Claim 7. The method of claim 6 wherein said first website is associated with a vendor.

Claim 8. The method of claim 1 wherein the retrieved additional information is presented to the user for verifying accuracy of said information.

Claim 9. The method of claim 8 further comprising the steps of:

verifying an accuracy of said retrieved additional information,

appending the additional information to the entered user information;

transmitting said entered information and said appended additional information;

and

processing said transmitted information to complete a transaction.

Claim 10. The method of claim 9 wherein the user selects portions of the additional information for transmission.

Claim 11. The method of claim 2 wherein the application is further programmable to search a database associated with the first location.

Claim 12. A system comprising:

a first website corresponding to a vendor of products or services, said first website having a storage medium containing user information corresponding to a plurality of individuals;

a second website having a storage medium containing user information corresponding to a plurality of individuals;

a network connecting said first and second websites; and

a user station connected to the network, the first website comprising a software application being programmable to communicate with the second website and to search and to retrieve user information from the storage medium at the first and second websites in response to information entered through a user interface of the user station, and wherein the software application is further programmed to determine the identity of a user by way of matching the information entered through the user interface of the user station to user information contained on the respective storage mediums of the first and second websites.

Claim 13. The system of claim 12 wherein the network is the Internet.

Claim 14. The system of claim 12, wherein said first website presents a plurality of products or services offered by a vendor.

Claim 15. The system of claim 14, wherein said first website includes links to additional information pertaining to said products or services.

Claim 16. The system of claim 12, wherein said first website facilitates a transaction between the user and the vendor.

Claim 17. The system of claim 12, wherein said first website contains information pertaining to a plurality of users.

Claim 18. The system of claim 12, wherein the user selects at least one product or service for purchase from the vendor.

Claim 19. The system of claim 18, wherein a user selection is displayed to the user.

Claim 20. The system of claim 19, wherein the user is prompted to enter information for shipping and billing purposes.

-- End of Claims Appendix --

(Continued on next page.)

9.   <u>Evidence Appendix:</u>

No evidence is submitted in the Evidence Appendix.

10.   <u>Related Proceedings Appendix:</u>

5   No evidence is submitted in the Related Proceedings Appendix.